

N. 2933

No. 14723

**United States
Court of Appeals
for the Ninth Circuit**

ROBERT C. WIAN ENTERPRISES, INC., a
Corporation,

Appellant,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Individually and as Partners, Doing Business
as Big Boy Manufacturing Company,

Appellees.

Transcript of Record

**Appeal from the United States District Court for the
Southern District of California,
Central Division.**

FILED

AUG 23 1955

No. 14723

**United States
Court of Appeals**
for the Ninth Circuit

ROBERT C. WIAN ENTERPRISES, INC., a
Corporation,

Appellant,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Individually and as Partners, Doing Business
as Big Boy Manufacturing Company,

Appellees.

Transcript of Record

**Appeal from the United States District Court for the
Southern District of California,
Central Division.**

INDEX

[Clerk's Note: When deemed likely to be of an important nature, errors or doubtful matters appearing in the original certified record are printed literally in *italic*; and, likewise, cancelled matter appearing in the original certified record is printed and cancelled herein accordingly. When possible, an omission from the text is indicated by printing in *italic* the two words between which the omission seems to occur.]

	PAGE
Amended Complaint	3
Certificate of Clerk	39
Motion to Dismiss, Etc.	16
Notice of	16
Names and Addresses of Attorneys	1
Notice of Appeal	31
Order of Dismissal	29
Statement of Point Relied Upon on Appeal (U.S.D.C.)	31
Statement of Points and Designation of Rec- ord, Appellant's (U.S.C.A.)	41
Stipulation Re Exhibits	42
Transcript of Proceedings of January 24, 1955	32

NAMES AND ADDRESSES OF ATTORNEYS

For Appellant:

GRAY, BINKLEY & PFAELZER,

458 S. Spring St.,
Los Angeles 13, Calif.

For Appellees:

GEORGE B. T. STURR,
ALBERT LEE STEPHENS, JR.,

535 Rowan Bldg.,
458 S. Spring St.,
Los Angeles 13, Calif.

In the District Court of the United States, Southern
District of California, Central Division

Civil Action No. 16497-HW

ROBERT C. WIAN ENTERPRISES, INC.,
Plaintiff,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Individually and as Partners d/b/a Big Boy
Manufacturing Company; DOE I, DOE II and
DOE III,

Defendants.

AMENDED COMPLAINT FOR INJUNCTIVE
RELIEF AND DAMAGES

The plaintiff alleges as follows:

First Cause of Action

I.

This is a civil action involving a sum or value exceeding \$3,000.00, exclusive of interest and cost for trade-mark infringement under the laws of the United States. The authority for the original jurisdiction of this Court is found in 60 Stat. 440, 15 U.S.C. § 1121 (1946).

II.

The plaintiff is now, and at all times mentioned herein was, a corporation, duly organized and existing under and by virtue of the laws of the State of California.

III.

The plaintiff is informed and believes, and on such [2*] information and belief alleges, that defendants L. O. Persinger and Merle Persinger at all times herein concerned were residents of Los Angeles County, California, and were engaged as partners in a manufacturing business conducted in Burbank, California, under the name of Big Boy Manufacturing Company.

IV.

Plaintiff is not aware of the true names or capacities, whether individual, corporate, associate, or otherwise, of defendants Doe I, Doe II and Doe III, and therefore sues said defendants by said fictitious names, and leave of Court will be asked to amend this complaint to show their true names and capacities when the same shall have been ascertained.

V.

Robert C. Wian, the plaintiff's predecessor, first engaged in the restaurant business in 1936, when he opened a single restaurant in Glendale, California, which he operated under the business name and style of "Bob's." In 1938 he developed a new type of hamburger sandwich that is now commonly referred to as a "Double Deck" hamburger sandwich. Mr. Wian thereupon gave to his new hamburger sandwich the name "Big Boy" and began selling and serving it to his customers. At about the same time, he caused to be created a design of

***Page numbering appearing at foot of page of original Certified Transcript of Record.**

a stout boy, dressed in checkered overalls and holding up a hamburger sandwich, one large bite out of which he appears currently to be enjoying. This design has ever since been used in the promotion of "Big Boy" hamburgers and has become widely recognized by the public as identifying those food products.

VI.

On May 1, 1946, Mr. Wian participated in the formation of the plaintiff corporation and transferred thereto his entire restaurant business, including all rights to the "Big Boy" trade-mark and trade name. The plaintiff corporation began immediately [3] to operate the restaurant business in the same manner as did its predecessor, and continues so to operate right down to the present time. As hereinafter used, the name "Wian" will refer to the business operated by Mr. Wian prior to May 1, 1946, and the business operated by the plaintiff from that date to the present.

VII.

The Wian operation has grown from the single restaurant established in 1936 until, at the present time, the plaintiff owns and operates ten restaurants in various communities of Southern California, including Glendale, Burbank, Eagle Rock, Pasadena and Van Nuys. During the year ending December 31, 1953, in excess of two million customers were served in the plaintiff's restaurants, and the gross receipts were in excess of \$3,500,000.00.

VIII.

Ever since "Big Boy" hamburgers were first originated in 1938, they have been sold and served in the Wian restaurants. Each hamburger has been delivered to the customer in a cellophane bag on which the words "Big Boy" and the design are prominently displayed. A photostatic copy of a sample of the bag originally used is attached hereto, marked "Exhibit A," and made a part hereof by this reference, as are all subsequent exhibits. "Exhibit B" displays a bag that is in current use.

IX.

Ever since 1938 the words "Big Boy" and the accompanying design have been constantly, regularly and widely advertised in Southern California in connection with the Wian restaurant operations. For example:

(a) "Big Boy" hamburgers have always been featured on the Wian menus; "Exhibit C" is a reproduction of a menu used prior to 1947, and "Exhibit D" is a copy of a current menu. [4]

(b) The paper bags in which orders "to go" are filled advertises the "Big Boy" ("Exhibit E").

(c) So does the back of the sales check ("Exhibit F").

(d) The business cards ("Exhibit G" and "Exhibit H") and the Wian stationery ("Exhibit I") have regularly publicized this featured Wian product.

(e) All of the Wian restaurants display large signs advertising themselves as "The Home of the

Big Boy.” The drive-in restaurant located at 910 East Colorado Street, Glendale, and pictured in “Exhibit J,” is typical.

(f) The “Big Boy” products have also been publicized by means of outdoor billboards (“Exhibit K”), signs on the Wian trucks, newspaper and magazine advertising, radio “commercials,” carnival and fair displays and exhibits, match covers, and by numerous other means.

(g) Even the Wian softball team bore the name “Big Boy” on its uniforms and was so publicized. “Exhibit L” is a clipping that represents the results of the 1950 season play-off at Pelanconi Park, which is in Glendale near the Burbank line.

X.

By means of the promotion and advertising described in paragraph “IX” hereof, the words “Big Boy” and the accompanying design have become widely recognized by the public in Southern California as identifying the entire Wian restaurant operation, and “Big Boy” has thus become a Wian trade name as well as a trade-mark.

XI.

In the past few years, the plaintiff has engaged in the business of granting franchises to other restaurant operators [5] in various parts of the United States, under which the licensee is given the exclusive right, in his geographical area, to sell hamburger sandwiches and other food products under the “Big Boy” name and design. In return for this

franchise, the licensee undertakes to pay to the plaintiff a monetary consideration, to adhere to the standards of quality set by the plaintiff, and to submit his operation to inspection by the plaintiff. At the present time, "Big Boy" food products are being sold by licensees of the plaintiff in the States of Illinois, Ohio, Kentucky, West Virginia, and Michigan. These licensees are likewise promoting and advertising their "Big Boy" hamburgers and other food products, with the result that the "Big Boy" trade-mark has become widely recognized throughout the United States as referring to food products of the plaintiff and its licensees. "Exhibit M" is a photographic reproduction of a restaurant operated by one of the plaintiff's licensees in Hazel Park, Michigan, under the name of "Dixie Drive-In." Negotiations are currently in process looking toward the establishment of franchises in Kansas, Wyoming and New Mexico, and it is the active plan of the plaintiff that "Big Boy" hamburgers and other food products will be sold, under the plaintiff's authority and supervision, in virtually every locality in the United States.

XII.

As a result of the widespread and long continuing use and advertising of the trade-mark and trade name of aforesaid, on and in association with the business and products of the plaintiff and its licensees, the said trade-mark and trade name are now, and since long prior to the acts herein complained of have been, extensively and favorably known to

the trade and to the public at [6] large and have come to be recognized throughout a large part of the United States as identifying the businesses of the plaintiff and its licensees; and by reason of the foregoing and of the high quality of their products and services, the plaintiff and its licensees have built up around said trade-mark and trade name good will and reputation of incalculable value.

XIII.

On July 15, 1952, there was duly and legally issued to the plaintiff a certificate of registration of United States Patent Office trade-mark number 561430. On May 19, 1953, there was duly and legally issued to the plaintiff a certificate of registration for United States Patent Office trade-mark number 574742. Copies of these certificates of registration are attached hereto, marked "Exhibit N" and "Exhibit O," respectively.

XIV.

Beginning sometime after 1950, the defendants began to engage in the business of manufacturing and selling, at wholesale and retail, various types of home barbecues, braziers and related accessories. They gave to their business the name "Big Boy Manufacturing Company" and advertised their products under the name "Big Boy," and they are still manufacturing and selling their products under that name.

XV.

Each barbecue and brazier offered for sale by the

defendants has affixed to it a decal, a photostatic copy of which is shown in "Exhibit P."

XVI.

An advertising booklet, currently circulated by the defendants, refers to "Big Boy Fire Box," "Big Boy Grill," "Big Boy Drip Dish," "Big Boy Skewer," in addition to "Big Boy Barbecues" and "Big Boy Grills," as constituting some of the items offered for sale by the defendants. [7]

XVII

"Exhibit Q" is a photostatic copy of the back cover of one of the defendants' current advertising booklets, and features what purports to be a picture of their place of business. It displays a large sign on the roof of the building which reads "Home of Big Boy Barbecues" in the same manner that Wian, ever since 1938, has advertised "Home of the Big Boy Hamburger." (See Exhibits C, F, G, I and J.)

XVIII.

The defendants display the words "Big Boy" on their business stationery. "Exhibit R" is a copy of a letterhead in current use.

XIX.

One of the defendants' advertising publications displays sketches that presumably depict the various food items that are conducive to preparation on the defendants' barbecues, such as hamburger,

ham, and steak, all of which items are served in the plaintiff's "Big Boy" restaurants. (See Exhibit Q.)

XX.

The plaintiff is informed and believes, and upon such information and belief alleges, that the defendants also advertise their products in many additional ways, including pamphlets, booklets, newspaper and periodical advertising, etc., all of which display the words "Big Boy."

XXI.

The defendants have sold their products extensively under the name "Big Boy" in Southern California, and they have also made similar sales in other states. The defendants advertise their products as "Made in California—Sold Across the Nation" and the plaintiff is informed and believes, and upon such information and belief alleges, that the defendants are currently attempting further to promote the sales of their products on a national scale. [8]

XXII.

The value of the good will embodied in the name "Big Boy" as the plaintiff's trade-mark and trade name referred to herein greatly exceeds the sum of \$3,000.00, and the conduct of the defendants, unless restrained, will greatly impair, if not destroy, the value of said good will.

Second Cause of Action

I.

Plaintiff refers to all of the allegations of plaintiff's first cause of action and by this reference makes them a part hereof.

II.

For a long time prior to the acts of the defendants herein complained of, they, and each of them, were familiar with the Wian restaurant operation, and well knew of the plaintiff's use and ownership of the "Big Boy" trade-mark and trade name. The defendants' use of the words "Big Boy" in the name of their business, in the names given to their items of manufacture, in their advertisements, and in various other ways, are deliberately calculated and intended to deceive and confuse, and necessarily tend to deceive and confuse, the purchasing public and to lead purchasers and prospective customers to believe, contrary to the fact, that the business of the defendants is associated or affiliated with that of the plaintiff, and that the activities of the defendants are authorized by the plaintiff and that the plaintiff is responsible therefor.

III.

The effect of the adoption and use by the defendants of the trade-marks of the plaintiff as described herein has been to enable the defendants to appropriate to themselves a portion of the business and good will heretofore enjoyed by the plaintiff and

to cause customers of the plaintiff and the public generally [9] to believe that the defendants and the plaintiffs are one and the same or in some way associated with each other or that the plaintiff has sponsored and approved the defendants' products.

IV.

Plaintiff is informed and believes and upon such information and belief alleges that the defendants by their conduct as described herein have deceived the public into the belief that it is purchasing the product of the plaintiff, resulting in the diminution of plaintiff's business and profits, loss of good will and other damage.

V.

The plaintiff first learned of the hereinabove-described infringement by the defendants shortly prior to August 21, 1953, and on said date, through its attorneys, the plaintiff gave notice in writing to the defendants with respect to said infringement and demanded that they desist from the practices herein complained of. The defendants, through their attorney, have persistently refused, and still refuse, so to desist, and they are still currently continuing to engage in the practices herein complained of. The plaintiff is informed and believes, and upon such information and belief alleges, that the defendants have profited financially through their unjustified use of the name "Big Boy" as hereinabove alleged. The plaintiff is not presently aware of the extent of such profit, inasmuch as the plaintiff does

not have access to the information upon which a determination of such profit would be based.

Third Cause of Action

I.

Plaintiff refers to paragraphs II, III, IV, V, VI, VII, VIII, IX, X, XI, XII, XIV, XV, XVI, XVII, XVIII, XIX, XX, XXI and XXII of plaintiff's first cause of action and paragraphs II, III, IV and V of plaintiff's second cause of action and by this reference makes [10] them a part hereof.

II.

The acts of the defendants as described herein constitute unfair competition. This cause of action is joined with a substantial claim under the Federal trade-mark laws, and the authority for the original jurisdiction of this Court is found in 62 Stat. 931, 28 U.S.C. § 1338 (1948).

Wherefore, the plaintiff prays:

1. That the defendants, and each of them, their servants, agents, attorneys, employees, successors, and assigns and all persons in active concert or participation with them, be restrained permanently by order and injunction of this Court:

(a) From directly or indirectly using in any way whatsoever the name "Big Boy" in any manner intended or calculated to indicate, or having the effect of indicating, that the defendants have any connection with the business of the plaintiff, and

from representing in any manner, by statements, advertising, conduct or otherwise, that the business of the defendants has any connection whatsoever with the business of the plaintiff;

(b) From using the words "Big Boy" in the name of the defendants' business;

(c) From using the words "Big Boy," or any simulation thereof, either alone or as a part of a phrase, on products, in advertising, on letterheads, business cards, telephone directory advertising, statements, signs, or otherwise;

(d) From aiding, abetting, or assisting others in the commission of the aforesaid acts; and

(e) From otherwise competing unfairly with the plaintiff.

2. That the defendants be required to account for the profits that they have made from the sale of all products sold by [11] them under the name and style of "Big Boy" and that judgment be granted to the plaintiff in the amount of such profits.

3. That the plaintiff have such other and further relief as to the Court may seem just, together with costs and disbursements in this action.

GRAY, BINKLEY &
PFAELZER,

By /s/ WILLIAM P. GRAY,
Attorneys for Plaintiff.

Affidavit of Service by Mail attached.

[Endorsed]: Filed November 1, 1954. [12]

[Title of District Court and Cause.]

MOTION TO DISMISS, ETC.

Notice of Motion

To: Gray, Binkley & Pfaelzer, Attorneys for Plaintiff:

Please Take Notice that the undersigned will bring the attached motions on for hearing before the above-entitled court, in the courtroom of the Honorable Harry C. Westover, Judge, in the United States Post Office and Court House Building, Los Angeles, California, on Monday, the 17th day of January, 1955, at the hour of 10:00 o'clock a.m., or as soon thereafter as counsel may be heard.

GEORGE B. T. STURR and

ALBERT LEE STEPHENS, JR.,

By /s/ ALBERT LEE STEPHENS, JR.,
Attorneys for Defendants, L. O. Persinger and
Merle Persinger. [38]

I.

Motion to Dismiss for Failure to State a Claim
Upon Which Relief Can Be Granted

Defendants L. O. Persinger and Merle Persinger, pursuant to Rule 12 (b) (6) of the Federal Rules of Civil Procedure, respectfully move the court that the plaintiff's complaint be dismissed upon the ground that the same fails to state a claim upon which relief may be granted.

II.

Motion to Dismiss the Second Cause of Action and the Third Cause of Action for Lack of Jurisdiction Over the Subject Matter.

Defendants L. O. Persinger and Merle Persinger, pursuant to Rule 12 (b) (1) of the Federal Rules of Civil Procedure, respectfully move the court to dismiss the Second Cause of Action and the Third Cause of Action of plaintiff's complaint on the ground that the court lacks jurisdiction over the subject matter thereof.

III.

Motion for a More Definite Statement

Defendants L. O. Persinger and Merle Persinger, pursuant to Rule 12 (e) of the Federal Rules of Civil Procedure, respectfully move the court for an order requiring that plaintiff make a more definite statement on the ground that the complaint is vague and ambiguous in the following respects and defendants cannot reasonably be required to frame a responsive pleading thereto. The difficulties complained [39] of and the details desired are as follows:

1. It is not ascertainable from the amended complaint, and particularly from paragraphs V, XI and XII of the allegations contained in the First Cause of Action and as incorporated by reference in the allegations of the Second and Third Causes of Action contained in said amended complaint,

wherein there is reference to "food products," "other food products" and "products";

a. How or in what manner the same are alleged to be related to the double-deck hamburger sandwich referred to in the amended complaint or the design of a stout boy eating a hamburger sandwich; or

b. How the words "Big Boy" are applied in the sale of such food products; or

c. What food products are being sold by plaintiff or its licensees in connection with the words "Big Boy";

d. Whether such food products are being manufactured by plaintiff or its licensees;

e. How or in what manner such food products have been identified with the promotion of Big Boy hamburgers other than being served in a restaurant which serves Big Boy hamburgers.

2. It is not ascertainable from the amended complaint, and particularly paragraph XII of the First Cause of Action alleged therein and as incorporated by reference into the Second and Third Causes of Action alleged therein, how and in what manner the words "Big Boy" have been identified with the businesses of plaintiff and its licensees as distinguished from the sale by plaintiff and its licensees of a hamburger sandwich called "Big Boy," and particularly the amended complaint and each cause of action alleged therein is vague and ambiguous concerning the establishment of any uni-

form quality of services [40] of plaintiff and its licensees.

3. Said amended complaint is further vague and indefinite in that in paragraph XIX of the First Cause of Action alleged therein and as incorporated by reference in the Second and Third Causes of Action, there is reference to “‘Big Boy’ restaurants,” while there is no allegation in the amended complaint or in any cause of action alleged therein that plaintiff or its licensees operate any restaurant by such name; on the contrary, it would appear from the amended complaint that the restaurants of plaintiff and its licensees are otherwise known and designated. See paragraphs V, VIII, IX and XI of the First Cause of Action and as incorporated by reference in the Second and Third Causes of Action alleged in the amended complaint and the exhibits therein referred to.

4. Said amended complaint is vague and indefinite in that there is no allegation of facts showing that the trade-marks of the plaintiff, referred to in paragraph XIII of the First Cause of Action alleged in said amended complaint and as incorporated by reference in the Second and Third Causes of Action alleged therein, were duly or legally or validly issued or are valid or that the use by defendants of the decal referred to in paragraph XV and shown in Exhibit P to the amended complaint is not the use of a valid trade-mark duly registered by defendants prior to registration of plaintiff's trade-marks or either of them.

5. It cannot be ascertained from the amended complaint or from any cause of action alleged therein whether plaintiff contends that the use of the words "Big Boy" has resulted in such words becoming a trade name in Southern California alone, as alleged in paragraph X of the First Cause of Action and as such paragraph is incorporated by reference in [41] the Second and Third Causes of Action alleged in the amended complaint, or in other places in the United States or elsewhere as well, as evidenced by paragraph XII of the First Cause of Action alleged in the amended complaint and as such paragraph is incorporated by reference in the Second and Third Causes of Action alleged in said amended complaint.

6. The amended complaint and each and every cause of action alleged therein is vague and ambiguous with respect to allegations concerning impairment or destruction of the value of the good will alleged to be associated with plaintiff's claimed trade-mark and trade name, particularly paragraph XXII of the First Cause of Action alleged in the amended complaint and as such paragraph is incorporated by reference into the Second and Third Causes of Action alleged in said amended complaint. in that no facts have been alleged in the amended complaint nor in the First, Second and Third Causes of Action designated therein which would indicate how the conduct of defendants, or either of them, has adversely affected, or could adversely affect, the value of the good will claimed

by plaintiff to exist with respect to its alleged trademark and trade name.

The details desired of plaintiff are apparent from the foregoing outline of the difficulties complained of by defendants. It is respectfully submitted that unless said details are furnished by plaintiff a responsive pleading will in effect constitute simply a denial of conclusions of law and that no issues of fact will be framed or indicated by the pleadings and that the subsequent conduct of the case will be difficult, particularly with respect to findings of fact and conclusions of law. [42]

IV.

Motion to Strike Immaterial Matter From Amended Complaint

Defendants L. O. Persinger and Merle Persinger, pursuant to Rule 12 (f) of the Federal Rules of Civil Procedure, respectfully move the court to strike from the amended complaint, and from the First, Second and Third Causes of Action alleged therein, the following allegations, on the ground that they are immaterial to the issues herein:

1. The allegation in paragraph I of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof, that the sum or amount involved exceeds \$3,000.00, exclusive of interest.

2. Allegations in paragraphs V, XI and XII of the First Cause of Action of the amended complaint

and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof, with respect to "food products," "other food products" and "products."

3. The allegations of paragraph XI of the First Cause of Action of the amended complaint, as incorporated by reference in the Second Cause of Action by paragraph I thereof, and as incorporated by reference in the Third Cause of Action by paragraph I thereof.

4. The allegations of paragraph XIII of the First Cause of Action of said amended complaint and as incorporated by reference in the Second Cause of Action by paragraph I thereof, and as incorporated by reference in the Third Cause of Action by paragraph I thereof, that "On July 15, 1952, there was duly and legally issued to the plaintiff a certificate of registration of the United States Patent Office trade-mark number 561430."

5. The allegations of paragraph XIX of the [43] First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof.

6. The allegations of paragraph XXI of the First Cause of Action of the amended complaint, and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as

incorporated by reference in the Third Cause of Action by paragraph I thereof, that "The defendants advertise their products as 'Made in California—Sold Across the Nation' and the plaintiff is informed and believes, and upon such information and belief alleges, that the defendants are currently attempting further to promote the sales of their products on a national scale."

Statement of Reasons

The Reasons in Support of the Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted Are as Follows:

1. The plaintiff's alleged trade-mark consists of common non-fanciful words which when used as a trade-mark are "weak" rather than "strong."

2. Even if such words have acquired a secondary meaning with respect to plaintiff's hamburger or other food products, defendants' use of such words as a trade-mark is with respect to non-competing goods which are not similar in any way to plaintiff's goods, are marketed through different channels and to a more discriminating class of consumers, and as a consequence there is little likelihood of confusion of source on the part of purchasers which would result in any damage whatsoever to plaintiff's business, good will or reputation. [44]

3. A claim for unfair competition which is joined with a claim for trade-mark infringement, under the Lanham Trade-Mark Act of July 5, 1946,

15 U.S.C.A., Sections 1051-1127, involves the same essential elements as the claim for unfair competition where plaintiff's and defendant's goods are non-competing, whether such claim of unfair competition be viewed as a cause of action arising under State Law or whether it be viewed as raising a Federal question under the Lanham Trade-Mark Act. In either event, where the goods involved are non-competing, the gist of the action for unfair competition is a likelihood of confusion on the part of consumers, and where the possibility of such confusion is remote or unlikely, the plaintiff is not entitled to relief by way of injunction, damages, recovery of defendant's profits, or otherwise.

The Reasons in Support of the Motion to Dismiss the Second Cause of Action and the Third Cause of Action for Lack of Jurisdiction Over the Subject Matter Are as Follows:

1. The amended complaint fails to state a substantial and related claim for trade-mark infringement under the laws of the United States.

2. When a complaint fails to state a substantial and related claim for trade-mark infringement under the laws of the United States, the Federal District Court is without jurisdiction over a claim for unfair competition which has been joined in the complaint with the claim for trade-mark infringement.

3. The Lanham Trade-Mark Act of July 5, 1946,

does not confer upon the Federal District Court jurisdiction over claims for unfair competition in the absence of the joinder of a substantial and related claim for trade-mark infringement under [45] the trade-mark laws of the United States in an action between citizens and residents of California, nor does it create a new Federal cause of action which may be asserted separately from a substantial and related claim for a trade-mark infringement under the laws of the United States in the absence of diversity of citizenship.

The reason in support of the Motion for a More Definite Statement is as follows:

The allegations of the amended complaint should be statements of fact subject to being controverted in the answer rather than bare conclusions of the pleader based upon inferences. Defendants believe that the amended complaint enlarges upon the development of the double-deck hamburger sandwich, called "Big Boy" in successive stages without additional facts, from Big Boy hamburgers to "those food products," "other food products," "products," " 'Big Boy' restaurants," "the entire Wian restaurant operation" and ultimately to identifying not only the plaintiff and its business, but also the unidentified businesses of its licensees and their products and their "services." A more definite statement of facts is required to enable defendants to intelligently answer and to frame a responsive pleading.

The Reasons in Support of the Motion to Strike
Immaterial Matter From Amended Complaint
Are as Follows:

1. The allegations sought to be stricken are immaterial to the issues sought to be raised by the amended complaint.

2. The allegation with respect to the amount in controversy in paragraph I of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof, is immaterial in a suit under the Lanham Trade-Mark Act of July 5, 1946, by virtue of the express provisions [46] of Title 15, U.S.C.A., Section 1121.

3. The allegations in paragraphs V, XI and XII of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof, with respect to "food products," "other food products" and "products" are immaterial because the allegations of the amended complaint show that plaintiff's right to the trade-mark or trade name with respect to the words "Big Boy," if they exist at all, exist only with respect to double-deck hamburgers.

4. The allegations of paragraph XI of the First Cause of Action as incorporated by reference in the Second and Third Causes of Action by paragraph I of such Second and Third Causes of Action, are immaterial to said Second and Third Causes of Action for the reason that such causes of action

are grounded in unfair competition and not in trade-mark infringement under the laws of the United States, and therefore any allegations in said Second and Third Causes of Action with respect to interstate commerce are unnecessary and immaterial because such causes of action are based either on State Law or general principles of unfair competition and not on power of Congress to regulate interstate commerce.

5. The allegations of paragraph XIII of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof, that "On July 15, 1952, there was duly and legally issued to the plaintiff a certificate of registration of the United States Patent Office trade-mark number 561430" is immaterial because relief or recovery in this action is not predicated upon such trade-mark or name infringement or unfair competition with respect thereto. [47]

6. The allegations of paragraph XIX of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof, are immaterial in that plaintiff's amended complaint does not set forth that plaintiff has established a trade-mark or trade name with respect to food products in general nor with respect to those which are mentioned in said paragraph, nor that the

plaintiff has the exclusive right to use the words "Big Boy" with respect to the sale and promotion of food products other than double-deck hamburgers.

7. The allegations sought to be stricken from paragraph XXI of the First Cause of Action and as incorporated by reference in the Second Cause of Action by paragraph I thereof and as incorporated by reference in the Third Cause of Action by paragraph I thereof, are immaterial and unnecessary for the reason that it is not alleged that defendants are not entitled to promote the sale of their products on a national scale and that the defendants are not entitled to advertise their products as "Made in California—Sold Across the Nation"; nor is it alleged that the defendants advertise or promote their products under such name on a national scale. [48]

Respectfully submitted,

GEORGE B. T. STURR and
ALBERT LEE STEPHENS, JR.,

By /s/ ALBERT LEE STEPHENS, JR.,
Attorneys for Defendants.

Receipt of copy acknowledged.

[Endorsed]: Filed December 20, 1954. [50]

In the District Court of the United States, Southern
District of California, Central Division

No. 16,497-HW

ROBERT C. WIAN ENTERPRISES, INC.,
Plaintiff,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Individually and as Partners d/b/a Big Boy
Manufacturing Company; DOE I, DOE II and
DOE III,

Defendants.

ORDER OF DISMISSAL

The above-entitled action having been commenced by the filing of a complaint against defendants and an amended complaint having been thereafter filed, and defendants having filed a motion to dismiss the same and said motion having come on regularly to be heard on the 17th and 24th days of January, 1955, the plaintiff being represented by Gray, Binkley & Pfaelzer, William P. Gray, Esq., appearing, and defendants being represented by George B. T. Sturr, Esq., and Albert Lee Stephens, Jr., Esq., Mr. Sturr and Mr. Stephens appearing, and the court having heard the arguments of counsel and having considered the points and authorities submitted in support of and in opposition to said motion, and having granted plaintiff leave to amend and plaintiff [52] having failed and refused to amend its said complaint within ten days from the

date of said hearing (ten days being the time counsel for the respective parties agreed upon as the time to be allowed for amendment thereof), and the court being fully advised in the premises,

Now Therefore, It Is Hereby Ordered, Adjudged and Decreed that the said amended complaint and the action based thereon be, and the same is hereby, dismissed for failure to state a claim upon which relief can be granted.

Dated: Feb. 7th, 1955.

/s/ HARRY C. WESTOVER,
United States District Judge.

Approved as to form:

GRAY, BINKLEY &
PFAELZER,

By /s/ MARTIN J. SCHNITZER,
Attorneys for Plaintiff.

Receipt of copy acknowledged.

[Endorsed]: Filed February 7, 1955.

Judgment docketed and entered February 8, [53]
1955.

[Title of District Court and Cause.]

NOTICE OF APPEAL

To the Defendants, L. O. Persinger and Merle Persinger, and Their Attorneys, George B. T. Sturr and Albert Lee Stephens, Jr.:

Notice is hereby given that Robert C. Wian Enterprises, Inc., the above-named plaintiff, hereby appeals to the United States Court of Appeals for the Ninth Circuit from the order of dismissal entered herein on February 8, 1955.

Dated: March 4, 1955.

GRAY, BINKLEY &
PFAELZER,

By /s/ MARTIN J. SCHNITZER,
Attorneys for Plaintiff-
Appellant.

Affidavit of Service by Mail attached.

[Endorsed]: Filed March 7, 1955. [54]

[Title of District Court and Cause.]

STATEMENT OF POINT RELIED
UPON ON APPEAL

Plaintiff herein intends to rely upon the following point in prosecuting its appeal from the Order of Dismissal entered in favor of the defendants herein:

1. The Court erred in granting the defendants' motion for an order of dismissal and in making said order.

Dated: March 18, 1955.

GRAY, BINKLEY &
PFAELZER,

By /s/ MARTIN J. SCHNITZER,
Attorneys for Plaintiff-
Appellant.

Affidavit of Service by Mail attached.

[Endorsed]: Filed March 21, 1955. [56]

In the United States District Court, Southern
District of California, Central Division

No. 16497-HW Civil

ROBERT C. WIAN ENTERPRISES, INC.,
Plaintiff,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Etc., Et Al.,

Defendants.

Honorable Harry C. Westover, Judge Presiding.

REPORTER'S TRANSCRIPT OF
PROCEEDINGS

Los Angeles, California

Appearances:

For the Plaintiff:

GRAY, BINKLEY & PFAELZER, by
WILLIAM P. GRAY, ESQ.

For the Defendants:

ALBERT LEE STEPHENS, JR., ESQ.

January 24, 1955—10:00 A.M.

The Clerk: No. 16497, Robert C. Wian Enterprises vs. L. O. Persinger, et al.

The Court: I do not know whether it is necessary to reargue this matter or not since last Monday I reread all the cases as to the law in this state and this Circuit, and unless you have some recent authorities, some new authorities, that I have not seen, I do not think it has to be reargued.

Mr. Stephens: No, your Honor. We simply wanted additional time to be able to present to your Honor with the memorandum in response to the respondent's memorandum.

The Court: I do not know if it is necessary to grant any additional time. This is not a new subject at all, this is just going over the same thing.

Mr. Stephens: I am not asking for additional time now, your Honor. I mean that is the reason we wanted the additional week.

The Court: Very well.

Mr. Gray: If the court please, we did argue this quite fully last week. I am not quite sure, as I look back upon it, that I made our position quite clear

in embracing the Sunbeam cases, which I did, and still do, and at the risk of persuading the court against the position in our favor, I would like to just make a couple of comments if the court [2*] would care to hear them.

The Court: I know, but there is really only one issue in this case. Your complaint sets up many things that I do not think have anything to do with the case. I do not think there are any aggravations here and your complaint does not show any violation of the trade-mark.

Mr. Gray: As far as the design is concerned.

The Court: As far as the design is concerned. So the only thing here is the trade name and the trade you are talking about is Big Boy.

Mr. Gray: That is right.

The Court: And that is all.

Now in this State the rule is that by getting a preferred right, let us assume that you have a preferred right, of a name you cannot exclude everybody from using that name in unrelated businesses.

Mr. Gray: That is true, your Honor.

The Court: So now the only issue in this case is the relation of the restaurant business to the manufacturing business, and that is all.

Mr. Gray: Not quite, your Honor, please. It is the relation of the restaurant business to the business of manufacturing a particular thing that you make, an item of food.

In other words, the touchstone is a hamburger. That is contrary to the Sunbeam case. [3]

*Page numbering appearing at top of page of original Reporter's Transcript of Record.

The Court: You do not claim any exclusive right to a hamburger, do you?

Mr. Gray: No, if your Honor please, but if you have traveled up on Highway 101, as you undoubtedly have, perhaps you have stopped at Buellton, halfway up the Coast, and partaken of Andersen's split-pea soup, which was there for years, and if you haven't done so I would commend it to you. But there was just a restaurant business.

Now you wouldn't suppose, however, that if somebody else should go into the business of packaging and freezing split-pea soup for home consumption and calling it Andersen's that there wouldn't be any likelihood of confusion.

The Court: That is right. But you have a manufacturing business here; you are not selling food.

Mr. Gray: I can't cover all things by one illustration.

On the other hand, your Honor, you do have two different businesses. One is a restaurant business, as you have said, and the other is a business of—well, a grocery business, if you please. Now they are distinct businesses.

Now supposing that this other person instead of packaging frozen food would develop a nice tureen to accommodate split-pea soup and would emblazon "Andersen's Split-Pea Soup Tureen" on it. Now that is your case.

It seems to me, if your Honor please, that you would not say then that there was no reasonable possibility of [4] confusion in that situation.

The Court: You may have a cause here of com-

petition, but that is a State issue. We have no jurisdiction unless we can establish in some way that there has been a violation of a trade-mark or a trade name.

Mr. Gray: There is some confusion, as I understand it, even with respect to that problem, your Honor. But, if I may point out, there is nothing in any of these cases that says that the relationship here is too remote. In the Sunbeam cases you have a fluorescent lamp as opposed to a home appliance. They enjoined the lamp, the actual table lamp, in that case.

The Court: Supposing I go out and manufacture a skillet and call it the Big Boy skillet. Can you stop me from manufacturing the skillet?

Mr. Gray: I will have to decide that case when it comes. I probably would try. But I wouldn't be as confident as I am of this one, if your Honor please.

Actually, although there is no requirement of competition in effect, if we wanted to argue the point from a strictly logical standpoint I suppose there is competition here. If a person is hungry for a hamburger he has two choices: one is to go down to our place and buy one, and the other is to make it himself. If he makes it himself, he provides the meat. If he is going to buy it at the store, it is [5] ours.

I don't like to labor the point. Of course the Time case doesn't help or hurt anybody. There Judge Mathes said clearly that the word "Time" is descriptive both of the plaintiff's magazine, the

timeliness of news, and also the defendant's transportation company, we get things there on time. In the other sense there is no relationship at all between the "time" on Time Magazine and a transportation business.

In our case that isn't so. They are both dealing with exactly the product that we have built up and given to our name.

I know I have said that so many times that it is redundant, but that is the thing about which we feel so strongly.

We go back to Judge Hand's comment that even though there is not necessarily competition, a person's trade-mark is his seal and anybody else that uses it for his own advantage takes something away from the owner of that trade-mark, even though he doesn't tarnish the reputation.

We think that particularly in this area that the term Big Boy connotes two things: first, Big Boy hamburgers and, second, meat products of a high quality, in other words, hamburgers of high quality.

The Court: If the defendants here were attempting to [6] establish a restaurant, I would go along with you, but they are not.

Mr. Gray: No, your Honor. They are establishing various home restaurants, you might say.

Another thing, too, if your Honor please, we have alleged and we will show that this copying was intentional.

The Court: Well, now, supposing that it was. Do we have any jurisdiction to go into that matter?

Mr. Gray: Not if the thing is too remote to con-

stitute a trade-mark infringement, but the cases are—and I neglected to cite some but I have read many cases—to the effect that if you have an intentional copying then the inclination of the court is not to be so restrictive in its determination of what constitutes a violation. A person who does a copying innocently, without knowledge of the other person's mark, is entitled to much more consideration and much more credit than one who is not doing it innocently.

The Court: If you want to, you can file an action in the Superior Court against the defendants for unfair competition and then you can show in that action that they have deliberately copied the name Big Boy and that they are unfairly competing with you. Now that could be shown here provided we had jurisdiction of either the copyright or the trade name.

Mr. Gray: We are aware of that. In fact, I think it is [7] debatable as to whether or not the Federal court has such jurisdiction in the absence of a trade-mark violation. We were aware of that when we brought our action. We do feel that you do have a trade-mark problem here, and even in the absence of that you have jurisdiction even if you didn't have, but we are not relying on unfair competition, we are relying on a trade-mark violation because of the relationship that exists here far closer than the Sunbeam case or the Time case.

The Court: I do not think the relationship is close enough. Consequently I will grant the motion to dismiss, with leave to file an amended complaint

if you so desire, and if you can file an amended complaint showing that there is a closer relationship. But I do not think that you have established your right in the food industry, in the restaurant business, so that you can carry over that right into a manufacturing business.

Mr. Gray: Even though the manufacture is related to the same product?

The Court: I do not think so. So the motion is granted. And will you prepare the order?

Mr. Gray: I trust you were looking at Mr. Stephens, your Honor.

The Court: I was.

Mr. Stephens: I will, your Honor. [8]

The Court: And without prejudice to filing an amended complaint.

Mr. Stephens: Very well.

[Endorsed]: Filed March 21, 1955. [9]

[Title of District Court and Cause.]

CERTIFICATE OF CLERK

I, Edmund L. Smith, Clerk of the United States District Court for the Southern District of California, do hereby certify that the foregoing pages, numbered 1 to 59, inclusive, contain the original:

Amended Complaint for Injunctive Relief and Damages.

Notice of Motion, Motion to Dismiss for Failure to State a Claim Upon Which Relief Can Be Granted, etc.

Order of Dismissal.

Notice of Appeal.

Statement of Point Relied Upon on Appeal.

Designation of Record on Appeal.

which, together with 2 volumes of Reporter's Transcript of Proceedings held on Jan. 17 and 24, 1955, in the above-entitled cause, constitute the transcript of record on appeal to the United States Court of Appeals in said cause.

I further certify that my fees for preparing and certifying the foregoing record amount to \$2.00, which sum has been paid by appellant.

Witness my hand and the seal of said District Court, this 11th day of April, 1955.

[Seal]

EDMUND L. SMITH,
Clerk;

By /s/ THEODORE HOCKE,
Chief Deputy.

[Endorsed]: No. 14723. United States Court of Appeals for the Ninth Circuit. Robert C. Wian Enterprises, Inc., a Corporation, Appellant, vs. L. O. Persinger and Merle Persinger, Individually and as Partners, Doing Business as Big Boy Manufacturing Company, Appellees. Transcript of Record. Appeal from the United States District Court for the Southern District of California, Central Division.

Filed April 12, 1955.

/s/ PAUL P. O'BRIEN,

Clerk of the United States Court of Appeals for the Ninth Circuit.

United States Court of Appeals
for the Ninth Circuit

No. 14723

ROBERT C. WIAN ENTERPRISES, INC.,
Appellant,

vs.

L. O. PERSINGER and MERLE PERSINGER,
Individually and as Partners, Doing Business
as Big Boy Manufacturing Company,
Respondents.

APPELLANT'S STATEMENT OF POINTS
AND DESIGNATION OF RECORD

The appellant hereby adopts as its statement of points to be relied on and designation of record the "Statement of Point Relied Upon on Appeal" and "Designation of Record on Appeal" heretofore filed

with the District Court of the United States, Southern District of California, and contained in the type-written transcript of record filed herein.

Dated: April 14, 1955.

GRAY, BINKLEY &
PFAELZER,

By /s/ MARTIN J. SCHNITZER,
Attorneys for Appellant.

Affidavit of Service by Mail attached.

[Endorsed]: Filed April 16, 1955.

[Title of Court of Appeals and Cause.]

STIPULATION RE EXHIBITS

It is hereby stipulated by and between the parties to the above-entitled action through their respective counsel that the exhibits attached to the original record as transmitted to the above-entitled court may be considered by said court without being reproduced in the printed record on appeal.

Dated: May 18, 1955.

GRAY, BINKLEY &
PFAELZER,

By /s/ MARTIN J. SCHNITZER,
Attorneys for Appellant.

ALBERT LEE STEPHENS, JR.,

By /s/ ALBERT LEE STEPHENS, JR.,
Attorney for Respondents.

[Endorsed]: Filed May 20, 1955.